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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/334,185	06/16/1999	FRANK LIEBENOW	GW98-0769/34	5042

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GATEWAY, INC.
ATTENTION: IP LAW GROUP (MAIL STOP SD-21)
14303 GATEWAY PLACE
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EXAMINER

BUI, KIEU OANH T

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 07/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/334,185

Applicant(s)

LIEBENOW, FRANK

Examiner

KIEU-OANH T BUI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/30/2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews, III et al. (U.S. Patent No. 6,025,837) in view of Mao et al (U.S. Patent No. 6,459,427/ or “Mao” hereinafter).

Regarding claim 1, Matthews, III et al (or “Matt” hereinafter) disclose a method for performing events for related programs, comprising: “maintaining a subset of program information for at least one related program of a given program with program information for the given program in an information handling system, and performing at least one program event for the given program and, based upon the subset of program information, the at least one related program”, i.e, Matt clearly discloses a system and a method for broadcasting programs with its program information itself to users as the program information of a related program of that program to users/viewers, for instance, as the user picks or chooses “Seinfeld” program (Fig. 5/item 126), a descriptive window box 128 shows the program information of the program “Seinfeld” itself, as the related program information, as the user chooses MORE for more supplemental information, “Last week” for the last episode of the current playing program (emphasis added), and “Comedy Club” (140) as another related program information of

“Seinfeld” (Fig. 5, and col. 9/lines 34 to col. 10/line 13), (which it exactly reads on the claim language of the present application).

Matt does not clearly show the step of “providing information associated with the subset of program information for the at least one related program” as claimed but providing a supplemental information about the selected program; however, Mao in an apparatus and method for web casting over digital broadcast TV network including offering program guide to viewers discloses that Morecast is used for offering additional information related to the programs being watched, i.e., advertisement related to programs being watched, or news related to the program being watched, even users can access to different subset of the real time information of programs being broadcasted (see Fig. 1, col. 3/lines 20-34 and col. 4/lines 33-58). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Matt’s system with disclosed technique of Mao in order to offer an enhanced information handling system that can provide information associated with the subset of program information for the at least one related program and performing the at least one related program to viewers as preferred.

As for claim 2, in further view of claim 1 above, Matt further discloses “the action of maintaining the program information for the given program, including the subset of program information for the at least one related program, in an electronic program guide (EPG)”, i.e, an EPG that displays program schedule information in accordance with one of a plurality of user selectable modes as storage means for maintaining the program information (Fig. 5 as illustration for an EPG, and Fig. 4/item 96 for a program memory for maintaining the program information EPG in section 104).

With respect to claim 3, the step of “obtaining user input based on the information provided; and performing program events based on the user input” are revealed by Matt as Matt clearly shows that the user can access the “Seinfeld” program with program information on 120 and MORE information as one clicks on 140, and other related programs with their subset of program information are provided and displayed on the television screen as the user clicks on “Last week” or “Comedy Club” at item 140 (Fig. 5, and col. 9/line 55 to col. 10/line 14).

Regarding claim 4, Matt further clearly discloses “wherein the action of performing program events includes recording the given program and the at least one related program” by scheduling a recording session for a particular related program, if desired (Fig. 8/step 216 and col. 12/lines 18-29).

As for claim 5, Matt discloses “wherein the subset of program information is appended to the program information for the given program”, i.e., as the user clicks on the program information of the given program, the subset of program information is displaying (col. 9/line 34 to col. 10/line 20).

Regarding claim 6, Matt discloses a system for performing events for related programs comprising: at least one processor (Fig. 4/item 92); memory operably associated with processor, i.e., either a volatile memory is of concern (Fig. 4/item 92) or a program memory (Fig. 4/item 96); and a program of instructions configured to be executed by processor and stored in memory, said program of instructions including instructions configured to maintain a subset of program information for at least one related program of a given program with program information for the given program in an information handling system, and perform at least one program event for the given program and, based upon the subset of program information, perform at least one program event for the at least one related program, i.e., an operating software program is used to control and configure instructions or commands in order to maintain and update the program schedule information including a subset of program information for at least one related program and to

perform the program event for any given program as preferred (Fig. 4/items 101, 104, and col. 8/lines 20-67).

Matt does not clearly show the step of “providing information associated with the subset of program information for the at least one related program” as claimed but providing a supplemental information about the selected program; however, Mao in an apparatus and method for web casting over digital broadcast TV network including offering program guide to viewers discloses that Morecast is used for offering additional information related to the programs being watched, i.e., advertisement related to programs being watched, or news related to the program being watched, even users can access to different subset of the real time information of programs being broadcasted (see Fig. 1, col. 3/lines 20-34 and col. 4/lines 33-58). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Matt’s system with disclosed technique of Mao in order to offer an enhanced information handling system that can provide information associated with the subset of program information for the at least one related program and performing the at least one related program to viewers as preferred.

As for claim 7, Matt shows “wherein said program of instructions further includes instructions configured to maintain the program information for the given program, including the subset of program information for the at least one related program, in an electronic program guide (EPG)”, i.e., an EPG that displays program schedule information in accordance with one of a plurality of user selectable modes as well as storage means for maintaining the program information with program of instructions” (see Fig. 4, and col. 8/lines 20-67 as discussed in claim 6 above).

With respect to claim 8, Matt further shows “wherein said program of instructions further includes instructions configured to obtain user input based on the information provided; and instructions configured to perform program events based on the user input” are shown by Matt as Matt shows that the user can access the “Seinfeld” program with program information on 120 and MORE information as one clicks on 140, and other related programs with their subset of program information are provided and displayed on the television screen as the user clicks on “Last week” or “Comedy Club” at item 140 (Fig. 5, and col. 9/line 55 to col. 10/line 14 with program of instructions as discussed in claim 6 above).

As for claim 9, Matt further discloses “a recording device”, i.e., recording scheduling programs (as shown in Fig. 8/item 216, and col. 9/lines 45-55 for a recording device).

With respect to claim 10, the step of “wherein the subset of program information is appended to the program information for the given program”, i.e., as the user clicks on the program information of the given program, the subset of program information is displaying (col. 9/line 34 to col. 10/line 20).

Regarding claims 11-19, these claims for “a computer readable medium tangibly embodying a program of instructions implementing the method above” and “a signal tangibly embodied in a propagation medium comprising at least one instruction configured to maintain; in an electronic program guide (EPG), a subset of program information for at least one related program of a given program with program information for the given program; at least one instruction configured to provide information associated with the subset of program information for the at least one related program; and at least one instruction configured to perform at least one program event for the given program and, based upon the subset of program information, the at least one related program and the information for the at least one related program” are rejected

for the reasons given in the scope of method and system claims 1-10 as already discussed in details above.

Response to Arguments

3. Applicant's arguments filed on 4/24/03 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., episodes of recurring programs, segments of a multi-part program, programs with similar content, and programs related through an intermediate program... related to independent claims 1, 6, 11 and 16) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claim language broadly calls for the steps of "maintaining a subset of program information for at least one related program of a given program with program information for the given program in an information handling system, and performing at least one program event for the given program and, based upon the subset of program information, the at least one related program" as disclosed by Matt in the Office Action. Matt does not show the step of "providing information associated with the subset of program information for the at least one related program" as claimed but providing a supplemental information about the selected program; however, Mao in an apparatus and method for web casting over digital broadcast TV network including offering program guide to viewers does disclose that Morecast is used for offering additional information related to the programs being watched, i.e., advertisement related to programs being watched, or news related to the program

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being watched, even many users can access to different subset of the real time information of programs being broadcasted (see Fig. 1, col. 3/lines 20-34 and col. 4/lines 33-58). Mao clearly points out that many users can access to different subset of the real time information of programs being broadcasted during specific viewing period (emphasis added). In other words, it reads on exactly the claiming step of "providing information associated with the subset of program information for the at least one related program" herein as programs with different subsets--related to those broadcasting programs with real-time information during that time period.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Matt and Mao reference are in a same environment of providing electronic program guide to viewers/users in a television broadcasting network. Furthermore, Matt suggests to provide a supplemental information about a selected program as discussed in the Office Action (Matt, Fig. 5, and col. 9/line 34 to col. 10/line 20). Then the teaching of Mao is obviously obtainable and reasonably combined as the additional information for a currently viewing program can be provided in real-time during a specific viewing period as suggested by Mao. The motivation is to provide users the easy and best way to access to additional information of interest of a desired program at the time the user watch or view a program. The rest of the arguments from the Applicant does not appear valid based at least on these reasons for

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independent claims 1, 6, 11 and 16. Therefore, the Examiner stands with the disclosure and teaching of Matt and Mao as disclosed in the previous Office Action and as discussed in this Final Office Action.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. **Any response to this action should be mailed to:**
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krista Kieu-Oanh Bui whose telephone number is (703) 305-0095. The examiner can normally be reached on Monday-Friday from 9:00 AM to 6:00 PM, with alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



ANDREW FAILE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Krista Bui
Art Unit 2611
June 24, 2003